

### **REMARKS**

Claims 15, 16, 20, 32, 34, 69, and 70 are presently pending in the instant application and were examined in the instant action. As provided in the arguments below, claims 15, 16, 20, and 69 have been amended such that all of the claims examined overcome these rejections. No new matter has been added by these amendments. Reconsideration and reexamination of the application, as amended, are respectfully requested in view of the amendments and arguments provided.

Applicants also respectfully request the examination of claims 71 and 72. These two claims were added in the response of January 2, 2009, but were said to be a non-elected group in the instant action. While not dependent upon claim 15, these two claims recite a compound contained within the broader generic structure of claim 15. Accordingly, they recite subject matter within the elected group. Applicants respectfully assert that they should be examined with the remaining claims.

Finally, new claim 73 is presented, which recites a method of inhibiting fatty acid synthase in a cell by administering an effective amount of a pharmaceutical composition comprising a pharmaceutical diluent and a compound of formula V. Support for this new claim is found, for example, on page 17, lines 15-17, page 19, lines 14-17, and in exemplified compounds 1, 2, 3, 4, 6, 7, and 12 on pages 36-38 of the Specification as filed. Favorable consideration and allowance of new claim 73 is respectfully requested because none of the references cited within the instant action set forth such a methodology.

**REJECTIONS UNDER 35 U.S.C. 103(A)**

**A. Rejection of claims 15, 16, and 32**

In the instant action, the rejection of claims 15, 16, and 32, was repeated under 35 U.S.C. 103, individually over the references Asano, *et al.*, Driloi, *et al.*, and Zhang, *et al.* While none of these references teach a species of compound recited in any of claims 15, 16, or 32. The Office Action contends that one of ordinary skill in the art would be motivated to modify the compounds taught to obtain compounds claimed because they are considered homologues.

Although Applicants respectfully disagree and maintain the arguments previously presented, in the interest of furthering prosecution claims 15 and 16 have been amended to remove the recitation that R<sup>21</sup> is a C<sub>2</sub>-C<sub>20</sub> alkyl group. Accordingly, the instant amendment overcomes the rejection of these claims in view of Asano, *et al.*, Driloi, *et al.*, and Zhang, *et al.* Therefore, reconsideration by the Examiner and withdrawal of this rejection is respectfully requested.

**B. Claims 20 and 34**

Claims 20 and 34 were rejected under 35 U.S.C. 103(a) as being independently unpatentable over Cavallito *et al.* and Pohmakotr *et al.* Specifically, both references were cited for teaching a compound of claim 20 wherein R<sup>27</sup> is comprised of a C<sub>13</sub> alkyl group. While neither of these references teaches a species of compound recited in claims 20 or 34, it was argued in the instant action that one of ordinary skill in the art would be motivated to modify such compounds taught to obtain compounds claimed because they are considered homologues.

Although Applicant respectfully disagrees with the stated position, in response to this rejection, claim 20 has been amended to remove C<sub>12</sub> alkyl and C<sub>14</sub> alkyl from the definition of R<sup>27</sup>. Applicants respectfully note that the remaining group has three to seven additional carbon atoms over the C<sub>13</sub> residue disclosed within the cited references. One of ordinary skill in the art would expect that such a change in the chemical structure would alter the chemical properties of the compounds, particularly the pharmacological activity. Indeed, Applicants point to the differences in the pharmacological data between compound 2 and compound 3 of the instant invention. There, a two carbon change in the R<sup>27</sup> position resulted in a significant change in biological activity. Applicants thereby respectfully assert that claims 20 and 34 are patentable in view of Cavallito *et al.*, and Pohmakotr *et al.* Reconsideration by the Examiner and withdrawal of this rejection is respectfully requested.

#### **REJECTIONS UNDER 35 U.S.C. 102(B) REJECTIONS**

##### **A. Claims 15, 16, and 32**

Claims 15, 16, and 32 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Kilminster *et al.* (U.S. Patent No. 4,753,871). Specifically, Kilminster was cited as disclosing a species of compound within the generic structure of claim 15, wherein R<sup>22</sup> is a phenyl group and R<sup>21</sup> is a C<sub>18</sub> alkyl group. As noted above, claims 15 and 16 have been amended to remove the recitation that R<sup>21</sup> is a C<sub>2</sub>-C<sub>20</sub> alkyl group. Accordingly, and for the reasons above, the instant amendment overcomes the rejection of these claims in view of Kilminster *et al.* Withdrawal of this rejection and reconsideration of the claims is respectfully requested.

#### B. Claims 15-16, 32, and 69-70

Claims 15-16, 32, and 69-70 are newly rejected under 102(b) as being independently anticipated by the following three references: De Azevedo *et al.*, Kamikawa *et al.*, and Haerdi *et al.* De Azevedo *et al.* was cited as disclosing a species of compound within the generic structure of independent claim 15, wherein  $R^{22}$  is  $-C_5H_{11}$  and  $R^{21}$  is a carboxylic acid group. Kamikawa *et al.* was cited as similarly disclosing a compound wherein  $R^{22}$  is  $-CH_3$  and  $R^{21}$  is a carboxylic acid group. Finally, Haerdi *et al.* was cited as disclosing a compound wherein  $R^{22}$  is a phenyl group and  $R^{21}$  is a carboxylic acid group.

Claim 15 has been amended to provide the proviso that when  $R^{21}$  is a carboxylic acid residue, then  $R^{22}$  is not  $-CH_3$ ,  $-nC_5H_{11}$ , and  $C_{13}H_{27}$ . Support for this amendment is found in at least pg. 16, lns. 1-5 of the original specification. These provisos specifically remove from the claim recitations those compounds allegedly disclosed in with De Azevedo *et al.* and Kamikawa *et al.* Accordingly, Applicants respectfully assert that claims 15-16, 32, and 69-70 are not anticipated nor rendered obvious by these two references. Withdrawal of this rejection and reconsideration of the claims is respectfully requested.

Claims 15 and 69 have also been amended to remove the recitation that  $R^{22}$  is an aryl group. This amendment removes from the claim the compound allegedly disclosed within Haerdi *et al.* Accordingly, Applicants respectfully assert that claims 15-16, 32, and 69-70 are not anticipated nor rendered obvious by this reference. Withdrawal of this rejection and reconsideration of the claims is respectfully requested.

#### CONCLUSION

Based on the foregoing, Applicant contends that this application is in a condition for allowance and an early notice to this effect is earnestly solicited. Should Examiner have any

questions or comments with respect to this response, it is respectfully requested that the Examiner telephone the undersigned at (215) 299- 2772 to discuss.

To the extent there are any fees required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, including extension fees, the Commissioner is authorized to charge all such fees to Deposit Account 50-1943.

Respectfully submitted,

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